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EXAMINER				
RETTA, YEHDEGA				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/687,499

Applicant(s)

WINSLADE ET AL.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to Request for Continued Examination filed June 4, 2010. Claims 34-36 have been amended. Claims 34-39 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 34 recites as follows:

offering, by a second system of a second party, an item for sale online at a sales price amount, *wherein the item for sale can be identified on the second system* **by a customer using the second system;**

providing a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale **on the second system**, the promotion having a promotion amount;

Applicant's specification (see page 44) teaches "(a)lternatively, a method of processing a coupon may comprise, for example, the following. A first party offers an item online for sale at a sales price amount. A coupon of a second party is associated with the item, the coupon having a coupon amount. A purchase request is received from a buyer for the item being offered online.

The purchase request is responded to by requiring the buyer to pay a purchase amount corresponding to the sales price amount less the coupon amount for the item. And the second party electronically pays a payment amount corresponding to the coupon amount to the first party". The specification however does not teach offering, by a second system of a second party, an item for sale online at a sales price amount, *wherein the item for sale can be identified on the second system by a customer using the second system.*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

offering, by a second system of a second party, an item for sale online at a sales price amount, *wherein the item for sale can be identified on the second system by a customer using the second system;*

providing a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale **on the second system**, the promotion having a promotion amount;

Claim 34 as amended recite "*wherein the item for sale can be identified on the second system by a customer using the second system*". Does it mean that the customer is using the second party's computer system? It is unclear what applicant considers a "system". If the items for sell are offered by a second system and if the customer is identifying the items using the second system, it is unclear whether the second system is a website, a server or a computer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US 6,915,271).

Regarding claim 34, Meyer teaches offering by a second system of a second party (merchants) items for sale at a sales price amount, wherein the item for sale can be identified by *a customer using the second system* (website, or webpage) (example of second system are Target, Holt, EB, amazon.com etc, circuit city see fig. 31-35, col. 16 lines 1-5, col. 39 line 55 to col. 41 line 22); providing a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale (a promotional sponsor (see col. 16 lines 6-67, for example, iq.com (see col. 38 line 60 to col. 40 line 67; wherein the customer can search for the promotion after the customer has identified the time for

sale on the second system, the promotion having a promotion amount (fig. 19-34); receiving, by the second system (merchants), online purchase request from customer for at least one item (buy now) (see col. 40 line 64 to col. 41 line 40); responding, by the second system, to the online purchase request by collecting from the customer a purchase amount corresponding to the sales price amount less the promotion amount (see col. 41 line 66 to col. 42 line 25) and electronically communicating, by the second system to the first system, an indication regarding the collection from the customer of the purchase amount (see col. 40 line 64 to col. 41 line 40, col. 42 line 1-64). The items of Meyer that are sold at the merchants (e.g. at Sony, Marriott, Target, amazon.com etc) can be identified by the customer before the customer browses at the coupon site. The customer can also browse the coupon site after identifying an item at the merchants to see if there is any coupon at the coupon site, or the customer can directly go the coupon site, click at the hyperlink to link to the merchant site and purchase the product using the discount.

Regarding claim 35, Meyer teaches offering, by a second system of a second party, an item for sale online at a sales price amount (see fig. 33 and 35 also col. 40 line 64 to col. 41 line 40), the item for sale having associated with it, by the second system of the second party, a promotion from the first party, the promotion having a promotion amount *wherein the second system is distinct from the first system and the second party is distinct for the first part* (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36) responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the

promotion amount (see col. 42 lines 1-36); and causing, by the second system, shipment by the second party of the item for sale to the buyer (see col. 41 lines 22-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 6,915,271) in view of Murphy et al. (US 2002/0052778 A1).

Regarding claims 36-38, Meyer teaches offering, by a second system of a second party, an item for sale online (see fig. 33 & 35 isavings), wherein the item has been acquired by the second party from the first-party (customer purchasing the items at the second party (promotional site)(see col. 40 line 67 to col. 41 line 2), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales-price amount less the promotion amount (see col. 42 lines 1-36). Meyer does not teach collecting, by the second system, a service fee from the buyer, it is taught in Murphy (see [0015]-[0018]). It would have been obvious to one of ordinary skill in the art at the

time of the invention to collect fee from the buyer as in Murphy in order to demonstrate the user's level of interest to the manufacturer or charge for the service provided by the second party.

Claims 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 6,915,271) in view of Holda-Fleck (US 5,729,693).

Regarding claims 36 and 39, Meyer teaches offering, by a second system of a second party, an item for sale online (see fig. 33 & 35 isavings), wherein the item has been acquired by the second party from the first-party (customer purchasing the items at the second party (promotional site)(see col. 40 line 67 to col. 41 line 2), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales-price amount less the promotion amount (see col. 42 lines 1-36). Meyer does not teach collecting, by the second system, a service fee from the buyer, it is taught in Holda-Fleck (see col. 3 lines 23-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to collect fee from the first party, as in Holda-Fleck, in order to charge for the service provided by the second party, as taught in Holda-Fleck.

Response to Arguments

Applicant's arguments filed June 4, 2010 have been fully considered but they are not persuasive.

Applicant argues that the item for sale can be identified on the second system by a customer using the second system. Applicant asserts that such identification on the second system by a customer using the second system is quite different than the purported teaching asserted by the Office action. Examiner points out that in Meyer the items for sale, for example at Target or amazon.com, can be identified by the customer through the Target website or amazon.com website respectively. After an item being identified by the customer the customer can access the isavings site to search for the promotions and purchase the item from the isavings site by linking to Target or amazon.com website. Applicant asserts that the specification (on pp. 15) discloses after selecting the desired items into a shopping cart, the customer invokes a rebate and coupon button on the screen ... if any items in the shopping cart are not specific enough to unambiguously ... The claim however does not recite selecting the item into a shopping cart or invoking a rebate or coupon on a screen. The claim recites that the item for sale can be identified on the second system and providing a portal containing a plurality of promotions wherein the customer can search for the promotion after the customer has identified the item for sale.

Applicant also argues that the mere existence of a separate website does not teach "providing a portal". Applicant however does not provide explanation on what applicant considers "a portal" or indicate the difference between a website and the "portal", as claimed by the applicant. Applicant discloses (see pp. 26) that the promotional offer posting 507 (see fig. 5) comprises of portal that lists a plurality of promotions such as coupons, rebate etc. Meyer, same as applicant's disclosure, teaches a webpage with listings of coupons that can be searched using a search engine.

Regarding claim 35, Applicant argues that "the "promotion sponsors" do not provide a promotion having a promotion amount (let alone a promotion amount wherein the second system collects "a purchase amount corresponding to the sales price amount less the promotion amount" as expressly recited by claim 35), so this portion of Meyer similarly fails to teach "...a promotion from the first party, the promotion having a promotion amount, wherein the second system is distinct from the first system and the second party is distinct from the first party." Similarly, as such organizations as described do not offer items for sale online or collect a purchase amount, Applicants respectfully submit such "promotion sponsors" again fail to teach a second party offering an item for sale on line or collecting a purchase amount and therefore cannot teach the second party as fully set forth by claim 35". Examiner respectively disagrees. Meyer teaches in an alternative embodiment of the buy now procedure, the purchase screen is a pop-up that asks the member for all information necessary to complete the purchase ... In yet another alternate embodiment, the service provider actually charges the purchase to the member's credit card, and then informs the vendor of the transaction, giving the vendor all information necessary for the vendor to fulfill the purchase (i.e., to send the product to the member)... the member then is provided with the necessary information to collect the goods or with a confirmation that delivery will take place... since an actual incentive redemption took place, the redemption recording activities described below also need to take place. Therefore, Meyer teaches a second party (service sponsor) selling items (vendor items) online having associated with it a promotion (provided by incentive issuer) (see col. 41 lines 23-41). Meyer also teaches that the sponsor may sponsor a campaign run directly by an incentive issuer (e.g., a manufacturer) or by a promotion agency... the promotion agency would then select the service provider to use for the promotional

campaign... an incentive issuer may run a promotion without using a third party ... in such case the incentive provider is incentive issuer... for example a merchant such as CIRCUIT CITY may issue a set of promotions related to goods sold at its store, and act as a sponsor of the promotion ... (col. 16 lines 47-67).

If applicant is indicating that in claim 36 the item has to be fiscally acquired by the second party from the first part, the vendors in Meyers also first acquire the products from the manufactures to be sold online. Meyers also teaches that the items acquired have a promotion from the manufactures or from the vendors themselves. Meyers teaches (see col. 22 line 31 to col. 23 line 20) each incentive is defined by an incentive template which is stored in database INCENT-DB 107... **Incentive Name** "sonycam-100" ... **Issuer**, *the identification of the manufacturer or supplier of the goods or services*, **Product**, a list of goods or services to which the incentive applies.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR
/Yehdega Retta/
Primary Examiner, Art Unit 3622